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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/697,269	10/26/2000	Christopher W. B. Goode	DIVA/002-CP2DV1	7527

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EXAMINER	
NALEVANKO, CHRISTOPHER R	
ART UNIT	**PAPER NUMBER**
2611	

DATE MAILED: 01/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/697,269	B. GOODE ET AL.	
	Examiner	Art Unit	
	Christopher R Nalevanko	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 August 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 08/25/2004 have been fully considered but they are not persuasive. Applicant argues, "Pocock is completely silent respect to the Applicants claimed 'monitoring, at a session control manager, and a use time associated with the requested title,' and 'restoring a previously terminated session an providing a requested title to a set top terminal if the use time associated with the requested title has not expired'. Furthermore, Swenson and Garfinkle fail to bridge the substantial gap as between Pocock and the Applicant's invention." (page 9 line 30 to page 10 line 4). Applicant further argues, "Garfinkle discloses 'a control system at the customer site that operates independently of the central station once the program has been down-loaded" (page 10 lines12-13). Examiner asserts that all of the claimed limitations have been met. Pocock clearly shows an interactive information distribution system to provide requested information (col. 3 lines 25-55, user receiving requested information) comprising receiving a title selection from a set-top terminal (col. 11 lines 35-40, user selected choice from menu) and, in the case of a first request, performing the steps of opening a session with the terminal (col. 9 lines 58-67, opening session with presentation system, col. 10 lines 54-67, opening viewing session) and providing the requested title to the terminal (col. 3 lines 40-50, transmitting presentation to viewers). Pocock is not used to show restoring a previously terminated session and providing the title to the user of the previously terminated session. This deficiency is shown by Swenson. Swenson clearly

shows, in the case of previously terminated session (col. 4 lines 55-67, stopping presentation and saving position, 'Stop & Save Position'), restoring the terminated session (col. 5 lines 9-13, position at which a subsequent request to play will be initiated, col. 5 lines 15-42, selecting a previous multimedia file) and providing the requested title to the terminal (col. 5 lines 15-42, saved "Title", typical bookmark function). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Pocock with the ability to continue a terminated session so that a user could continue watching a video at his or her convenience. Finally, Garfinkle is used to show the use of a use time associated with a selected video (col. 3 lines 25-55, prescribed time period, limits the number of times a video maybe viewed, or a combination of viewing methods), as well as supplying the video if the use time has not expired (col. 3 lines 25-55). Garfinkle further shows monitoring at a session control manager (col. 4 lines 5-48, using microprocessor, time-of-day clock, synchronization data to determine if the use time has expired), the use time. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Pocock and Swenson with the ability to associate a use time with the requested video so that the user could only watch the video for a predetermined amount of time before purchasing the video again, increasing the revenue from the on-demand system.

2. Applicant's arguments filed 08/25/2004 have been fully considered but they are not persuasive. Applicant further argues, "The combined references fail to teach or suggest the Applicants' claimed features of "monitoring, at a session control manger, a use time associated with the requested title."...Specifically, Garfinkle teaches that the use time

associated with the requested title is determined at the set top terminal. By contrast the Applicant's invention monitors, at a session control manager, a use time associated with the requested title. The session control manager shown in FIG. 1 of the Applicants' invention is part of the provider equipment, as opposed to the customer equipment (set top terminal)" (page 10 line 25 to page 11 line 7). There is nothing in the claimed limitation that describes the "session control manager" being at a central location or provider equipment. Because of this, the monitoring by a session control manager can take place at the user terminal, as shown by Garfinkle. Garfinkle shows the use of a use time associated with a selected video (col. 3 lines 25-55, prescribed time period, limits the number of times a video maybe viewed, or a combination of viewing methods), as well as supplying the video if the use time has not expired (col. 3 lines 25-55). Garfinkle further shows monitoring at a session control manager (col. 4 lines 5-48, using microprocessor, time-of-day clock, synchronization data to determine if the use time has expired), the use time.

3. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., monitoring, at a session control manager, part of the provider equipment, page 11 lines 3-6) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

4. In response to applicant's argument that "the combined teachings fail to solve the problem that the Applicants' invention solves" (page 11 lines 10-11), a recitation of the

intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

5. Regarding Claims 8, 9, 11, and 14, Applicant's failure to adequately traverse the Examiner's taking of Official Notice in the last office action is taken as an admission of the facts noticed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pocock et al in further view of Swenson et al and Garfinkle.

Regarding Claim 1, Pocock shows an interactive information distribution system to provide requested information (col. 3 lines 25-55, user receiving requested information) comprising receiving a title selection from a set-top terminal (col. 11 lines 35-40, user selected choice from menu) and, in the case of a first request, performing the

steps of opening a session with the terminal (col. 9 lines 58-67, opening session with presentation system, col. 10 lines 54-67, opening viewing session) and providing the requested title to the terminal (col. 3 lines 40-50, transmitting presentation to viewers). Pocock fails to show restoring a previously terminated session and providing the title to the user through the previously terminated session. Swesons shows, in the case of previously terminated session (col. 4 lines 55-67, stopping presentation and saving position, 'Stop & Save Position'), restoring the terminated session (col. 5 lines 9-13, position at which a subsequent request to play will be initiated, col. 5 lines 15-42, selecting a previous multimedia file) and providing the requested title to the terminal (col. 5 lines 15-42, saved "Title", typical bookmark function). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Pocock with the ability to continue a terminated session so that a user could continue watching a video at his or her convenience.

Neither Pocock nor Swenson show a use time associated with the requested video. Garfinkle shows the use of a use time associated with a selected video (col. 3 lines 25-55, prescribed time period, limits the number of times a video maybe viewed, or a combination of viewing methods), as well as supplying the video if the use time has not expired (col. 3 lines 25-55). Garfinkle further shows monitoring at a session control manager (col. 4 lines 5-48, using microprocessor, time-of-day clock, synchronization data to determine if the use time has expired), the use timeIt would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Pocock and Swenson with the ability to associate a use time with the requested video so

that the user could only watch the video for a predetermined amount of time before purchasing the video again, increasing the revenue from the on-demand system.

Regarding Claim 2, Garfinkle shows associating a view time (col. 2 lines 20-25, col. 3 lines 45-50).

Regarding Claim 3, Garfinkle shows not providing the title if the view time has expired (col. 4 lines 30-48).

Regarding Claim 4, it is inherent and understood that if the use time of a requested video expires, a user may open a new video session with a new use time.

Regarding Claim 5, it is inherent and understood in Garfinkle that if the view time has expired, a user may open a new video session with a new use and view time.

Regarding Claim 6, Swenson shows beginning at a previous termination point (col. 5 lines 3-25).

Regarding Claim 7, Swenson shows the ability to begin the transmission at a title start point designated by the user (col. 5 lines 3-54).

Regarding Claim 8, Garfinkle shows that a set-top terminal can be associated with an account and that the use time defines the time within which the title maybe accessed (col. 2 lines 5-8, lines 20-25, col. 3 lines 45-50). Pocock, Swenson, and Garfinkle fail to specifically show incurring additional charges. Official Notice is taken that it is well known and expected in the art to charge a user more when a predetermined using time has expired. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Pocock, Swenson, and

Garfinkle with the ability to charge for extra viewing time so that the distributor could create more revenue.

Regarding Claim 9, Garfinkle shows that a set-top terminal can be associated with an account and that the view time defines the amount of time the requested title maybe presented (col. 2 lines 5-8, lines 20-25, col. 3 lines 45-50). Pocock, Swenson, and Garfinkle fail to specifically show incurring additional charges. Official Notice is taken that it is well known and expected in the art to charge a user more when a predetermined viewing time has expired. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Pocock, Swenson, and Garfinkle with the ability to charge for extra viewing time so that the distributor could create more revenue.

Regarding Claim 10, Garfinkle shows blocking, erasing, or terminating a title when the use time has been expired (col. 2 lines 20-37).

Regarding Claim 11, Pocock, Swenson, and Garfinkle fail to specifically state terminating an open session when the presentation is concluded. Official Notice is given that it is well known and expected in the art to terminate a session when a presentation has conclude. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Pocock, Swenson, and Garfinkle with the ability to terminate a finished session to free up available bandwidth in the communication system.

Regarding Claim 12, Swenson shows terminating a session after the title has requested to be halted (col. 5 lines 3-55).

Regarding Claim 13, Garfinkle shows blocking, erasing, or terminating a title when the view time has been expired (col. 2 lines 20-37).

Regarding Claim 14, Pocock, Swenson, and Garfinkle fail to specifically state terminating an open session when the presentation is concluded. Official Notice is given that it is well known and expected in the art to terminate a session when a presentation has conclude. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Pocock, Swenson, and Garfinkle with the ability to terminate a finished session to free up available bandwidth in the communication system.

Regarding Claim 15, Swenson shows terminating a session after the title has requested to be halted (col. 5 lines 3-55).

Regarding Claim 16, Swenson shows associating a time with the halted presentation (col. 5. lines 45-50). It is inherent that a time variable is incremented.

Regarding Claim 17, Swenson shows a stop and pause command (col. 5 lines 3-55).

Regarding Claim 18, Swenson shows associating a time with the halted presentation (col. 5. lines 45-50). It is inherent that a time variable is incremented.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R Nalevanko whose telephone number is 703-305-8093. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on 703-305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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